

REMARKS

Status of Claims

Claims 1-6 are all the claims pending in the application. Claims 1-5 are withdrawn from consideration. Thus, claim 6 is the only claim considered by the Examiner and is rejected.

Response to Declaration Under C.F.R. §1.132

Applicants thank the Examiner for acknowledging Applicants' Rule 132 Declaration by Jihyun Kim filed October 18, 2007.

Withdrawn Rejections

Applicants thank the Examiner for withdrawing the rejection to Claim 6 under 35 U.S.C § 102(b).

Response To Claim Rejection Under 35 U.S.C. § 103

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Spiegel (U.S. Pub. No. 20040082657; "Spiegel") and in view of Park et al. (U.S. Pub. No. 2005/0130912; "Park").

The Office Action asserts that Spiegel teaches a method and composition for suppressing the appetite of a human being using L-theanine. The Office Action asserts that the method of Spiegel comprises the step of orally administering a composition comprising an appetite-suppressing amount of L-theanine which can be in a solid form or liquid form and may be further combined with one or more inert ingredients or one or more additional active ingredients. The appetite suppressant composition of Spiegel is asserted to provide a natural way of suppressing the appetite of a human being without causing the side effects associated with conventional appetite suppressants. The Office Action asserts that L-theanine and D-theanine are included in the appetite suppressant composition. In addition, the Office Action asserts that Spiegel teaches

that additional active ingredients may include L-carnitine, and an appetite suppressant selected from the group consisting of caffeine, ephedrine, phenylpropanolamine (PPA), L-glutamine, L-glutamic acid and mazindol (see Claims 9 and 10 of Spiegel).

Park is asserted for teaching a composition comprising genistein at 0.001 to 30 wt % to the total weight of the composition (see paragraph 0019 of Park), and a composition comprising L-carnitine at 0.001 to 50 wt % to the total weight of the composition (see paragraph 0023 of Park). In addition, the Office Action asserts that Park teaches a composition comprising genistein and L-carnitine for treating obesity (see paragraph 0024 of Park).

Thus, the Office Action asserts that one of ordinary skill in the art would have been motivated to use theanine, genisteine, L-carnitine, and caffeine because of their anti-suppressant properties to produce a composition that has a slimming effect. The Office Action appears to assert that since the cited documents teach products with identical or substantially identical chemical structure, the properties Applicants disclose and/or claim are necessarily present to establish a *prima facie* case of obviousness.

In response, Applicants note that the Office Action has failed to establish a *prima facie* case of obviousness for at least the following reasons.

First, the combination of Spiegel and Park does not teach or suggest all of the claim limitations. M.P.E.P. § 2143. In this regard, Spiegel does not teach or suggest genisteine or catechin. Further, Spiegel teaches away from using caffeine when L-theanine is present. As disclosed at the last sentence of paragraph [0014] of Spiegel, “if L-theanine is used with an additional appetite suppressant, the additional appetite suppressant is preferably not a stimulant such as caffeine.”

Second, with regard to Park, Applicants note that Park is assigned to Amorepacific Corporation and published on June 16, 2005¹. Accordingly, Park is antedated by the priority documents, Korean Application No. 10-2003-0026015 filed April 24, 2003 and Korean Application No. 10-2003-0098859, filed December 29, 2003, sworn English translations of which are submitted herewith.

Thus, because Park appears to be relied upon by the Office Action for teaching the combination of genistein and L-carnitine for treating obesity, the deficiencies of Spiegel cannot be cured, and the Office Action has failed to establish a *prima facie* case of obviousness.

Reconsideration and withdrawal of the rejection under § 103(a) is respectfully requested.

¹ Pursuant to M.P.E.P. § 2144.08, each reference must qualify as prior art under 35 U.S.C. 102.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,

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